

REMARKS

1. Claims 35-42 and 51-66 are currently pending in the application and all have been amended. Claims 67-69 have been cancelled. Claims 70, 71 and 72 are new. No new matter has been added.

Claim Rejections under 35 U.S.C. §§ 101 and 112

2. The Examiner has rejected claims 67, 68, and 69 under 35 U.S.C. §§ 101 and 112 on pages 6 – 8 of the Office Action, and has indicated that Applicant's arguments filed in its July 7, 2009, response regarding the Examiner's previously issued rejections under 35 U.S.C. §§ 101 and 112 of claims 35 – 42 and 51 – 66 are not persuasive (although the Examiner has not rejected those claims again in the Office Action). Below, the Applicant addresses all of the pending claims as meeting the requirements of 35 U.S.C. §§ 101 and 112.

3. All pending claims constitute patent-eligible subject matter under 35 U.S.C. § 101. As amended, claims 31, 35 and 59 are directed to a *system* that includes a *memory* operable to store a program and a *processor* communicatively coupled to the memory, in which the program, when executed by the processor, causes the processor to perform the recited method. New claims 70, 71 and 72 are directed to a computer readable storage medium having stored thereon computer executable instructions that, when executed on a computer, configure the computer to perform the recited method. In accordance with the Interim Examination Instructions for Evaluating Subject matter Eligibility Under 35 U.S.C. § 101, such claims qualify as a manufacture (“[A] claim to a non-transitory, tangible computer readable storage medium *per se* that possesses structural imitations under the broadest reasonable interpretation standard to qualify as a manufacturer would be patent-eligible subject matter.”) The Examiner is also directed to U.S. Patent Application Serial Nos. 11/592,710 and 11/638,341, also owned by the Assignee of the present application, which have similar claims and have been allowed.

4. All pending claims comply with 35 U.S.C. § 112, first and second paragraphs.

With regard to the second paragraph of section 112, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent

coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989). Thus, omissions in the specification do not render a patent invalid under the enablement standard, unless the omissions cause one skilled in the art to perform undue experimentation in order to practice the invention. *Hormone Research Foundation v. Genentech, Inc.*, 708 F. Supp. 1096, 1107 (N.D. Cal. 1988), *aff'd in part, vacated in part, and remanded*, 904 F.2d 1558 (Fed. Cir. 1990). Applicants respectfully submit that the specification as-filed enables the claimed invention because one of ordinary skill in the art would be able to make or use the invention based on the specification, and from what is known in the art, without undue experimentation.

Specifically, claims 31, 35 and 59 require a memory operable to store a program and a processor communicatively coupled to the memory, in which the program, when executed by the processor, causes the processor to perform the method of providing liquidity to a transaction in the recited manner. Similarly, new claims 70 – 72 are directed to a computer readable storage medium having stored thereon computer executable instructions that, when executed on a computer, configure the computer to perform the recited method of providing liquidity. The method by which liquidity is provided is identified in the claims (i.e., upon receiving a payment for principal of the term note, crediting the payment to principal of the money market note if the principal of the money market note is not fully credited, and crediting the payment to principal of the term note if the principal of the money market note is fully credited) and described in detail in the specification. *See*, at least, Figs. 1 and 2, and paragraphs [0041] and [0042] of the published application.

Further, that such method is carried out by a processor executing a program (as in claims 31, 35, and 59) or through instructions stored on a computer readable storage medium and executed on a computer (as in claims 70-72), is both disclosed in the specification and capable of being practiced by one skilled in the art, in view of the disclosure in the specification, without undue experimentation. In particular, the specification makes clear that the collecting and crediting may be accomplished electronically. *See* page 4 lines 16-20 (“A ‘collection’ is a receipt of a payment from a payor. The collection represents a transfer of money, but the transfer does not necessarily, literally, involve a movement of cash. The transfer may be represented by a journal entry, which in turn, may be represented in an electronic format, e.g., an electronic funds

transfer.”); page 4, lines 22-25 (“A ‘credit’ is an allocation of money to, or for the benefit of, an entity. In practice, the credit need not be an actual movement of cash, but may be represented by a journal entry for an account, which in turn, may be represented in an electronic format.”); page 5, lines 12-17 (“Money market note 130 and term note 140 are financial securities. As such, they may be embodied in a tangible form, such as a certificate, or in an electronic form, such as a data record or file associated with an account. In any case, the arrangement described herein can be memorialized by provisions in, or otherwise associated with, money market note 130 and term note 140, or in a separate document or contract.”). Such activities, if conducted electronically, must *necessarily* be performed through instructions executed by a computer. Electronic transfers cannot be performed without using computers. Furthermore, in view of the specific methods described in the specification for providing liquidity and what is well-known in the art with regard to using computers to assist with financial transactions, one skilled in the art would be enabled to practice the invention by employing a computer program to carry out the steps recited in the claims.

With regard to section 112, first paragraph, the written description requirement, Applicant respectfully submits that the written description requirement does not require the specification to describe or define claim limitations known to those of ordinary skill. *See* MPEP § 2163(II)(A)(3)(a):

“What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. . . . If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.”

As described above, the specific manner of providing liquidity to a transaction is set forth in the specification and use of computers that are programmed to perform such steps would be well-known to those skilled in the art. The fact that the words “memory”, “processor”, “computer readable storage medium”, and “computer” are not used in the specification clearly is not dispositive of the issue. The inventors were in possession of the claimed invention when the application was filed, as evidenced by the detailed description of how the method of providing

liquidity is carried out, as well as the reference to the fact that the collecting and crediting steps can be performed electronically, and data relating to the notes be stored electronically.

Applicants therefore respectfully submit that for at least the above reasons, the specification does in fact enable the pending claims and there is adequate written description. Applicants submit that rejection of claims under 35 U.S.C. § 112, first and second paragraphs, should be reconsidered and withdrawn.


CONCLUSION

In view of the foregoing Amendment and remarks, Applicant respectfully submits that all pending claims are in condition for allowance and such action is respectfully requested.

The Director is hereby authorized to charge any necessary fees, including extension fees under 37 C.F.R. § 1.17(a), or credit any overpayments in connection with this submission to Deposit Account No. **50-0310** (Billing No. 101612-5026US).

Respectfully submitted,
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